

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-38 are pending in this application. Claims 5, 12, 16, 22, 29, and 33 have been amended by being rewritten in independent form to include all of the limitations of the corresponding base claim and the limitations of any intervening claim. Accordingly, the amendments to Claims 5, 12, 16, 22, 29, and 33 are supported and introduce no new matter and the amendment thereof clearly involves no new issues and does not require a new search. Entry of this Amendment is, thus, believed to be in order.

The outstanding Office Action presents a rejection of Claims 1, 11, 15, 17, 18, 28, 32, and 34 as being unpatentable over Coiera (U.S. Patent No. 5,572,636) in view of Voit (U.S. Patent No. 6,075,783), a rejection of Claims 2-4 and 19-21 as being unpatentable over Coiera in view of Voit in further view of Xu et al. (U.S. Patent No. 6,151,628, Xu) under 35 U.S.C. § 103(a), a rejection of Claims 14 and 31 as being unpatentable over Coiera in view of Voit in further view of Dussell et al. (U.S. Patent No. 5,938,721, Dussell) under 35 U.S.C. § 103(a).

Applicants acknowledge with appreciation the allowance of Claims 35-38 and the indication that Claims 5-10, 12, 13, 16, 22-27, 29, 30, and 33 are only objected to because they depend upon a rejected base claim and would be allowed if rewritten in independent form including all the limitations of the base claim and any intervening claims. As Claims 5, 12, 16, 22, 29, and 33 have been so rewritten in the suggested independent form (to include all of the limitations of the corresponding base claim and the limitations of any intervening claim) allowance of Claims 5, 12, 16, 22, 29, and 33 is believed to be in order. Further, as Claims 6-10 all ultimately depend from Claim 5, Claim 13 depends on Claim 12, Claims 23-27 all ultimately depend from Claim 22, and Claim 30 depends from Claim 29, allowance of these dependent claims is also believed to be in order.

Before considering the outstanding prior art based rejections, Applicants again believe that a brief review of the present invention would be helpful. In this respect the present invention defined by the rejected claims includes, *inter alia*, a communication system and corresponding method adapted to enable a telephone/Internet connection between a mobile subscriber station of a cellular radio communication network and a specified Internet user the mobile subscriber station is seeking to establish a connection with. The cellular radio communication network includes a short message service (SMS) and the communication system includes a telephony/Internet server adapted to facilitate establishment of the desired telephony/Internet connection. In operation, the SMS provides information from the mobile subscriber station to the telephony/Internet server that identifies the Internet address of the specified Internet user that the mobile subscriber station would like to place a telephone call to. The telephony/Internet server then replies to receipt of this inquiry information by sending return information via SMS to the mobile subscriber station which, at a minimum, specifies if the telephony/Internet connection sought by the mobile subscriber station is possible.

Turning to the rejection of Claims 1, 11, 15, 17, 18, 28, 32, and 34 as being unpatentable over Coiera in view of Voit it is first noted that there would have been no reason for the artisan to attempt to modify the Coiera “on call” system by the disparate “follow-me” type routing teachings of Voit.

In this last regard, the basic operating principle of the Coiera “on call” system is that the caller is not seeking to connect to any particular PC. Instead, in the Coiera “on call” system a call is placed to a server to have that server inform one of many available “on call” individuals assigned to play a “role” that they are needed to perform that role. Thus, the basic operating principle of the Coiera “on call” system

is to provide a list of “role” players so that if the first listed “role” player does not respond (see column 5, lines 31-37 and column 5, line 65-column 6, line 5, for example) or responds negatively (see column 2, lines 61-67, for example) the next on the list is contacted.

Accordingly, it is believed to be clear that the “follow-me” type routing service illustrated in FIG. 4 of Voit (that checks for mobile telephone service after checking PC availability by pinging) would have no applicability to the disparate Coiera “on call” system that operates by simply going to the next listed “on call” person if the first does not answer or answers with a negative response.

In this last respect, it is well established that there must be a valid suggestion or motivation presented by the PTO to support the proposed modification to the references as fully discussed in MPEP §2143.01. The last paragraph of this section (on page 2100-127, Rev. 1, Feb. 2003) then notes that *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) establishes that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims [being rejected over these references] *prima facie* obvious.” As the modification to the Coiera “on call” system that is suggested in the outstanding Action rejection of Claims 1, 11, 15, 17, 18, 28, 32, and 34 would change the basic operation of the Coiera invention that provides an on call list and simply goes to the next listed individual if the previous one does not answer or declines the role, it is, by definition, not a valid *prima facie* case of obviousness and it is traversed for this reason.

In addition, the outstanding Action presents no explanation of reasons why the artisan would have been motivated to even select these clearly disparate references for combination.

See In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“In other words, the [PTO] must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”). As further noted in Rouffet, at 47 USPQ2d 1458, the PTO reviewing court requires that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” This has not been done and this rejection of Claims 1, 11, 15, 17, 18, 28, 32, and 34 as being unpatentable over Coiera in view of Voit is traversed for this reason as well.

Furthermore, FIG. 4 of Voit is not described at column 9, line 7-column 10, line 67 as indicated at page 3 of the outstanding Action. Instead, column 9, line 7-column 10, line 67 relate to describing the system of FIG. 2 and the showing of FIG. 3 in which an intelligent processing system first “pings” a PC to see if it is on, and, if it is not, checks to see if the called person has another telephone, either wireline or cellular phone for call completion. See column 10, lines 33-67.

In any event, as there is no disclosure in this column9-10 brief description of a “follow-me” type routing functionality, or the more detailed actual discussion of FIG. 4 (starting at line 1 of column 11), teaching or suggesting all of the subject matter of apparatus base Claim 1 (requiring, *inter alia*, the SMS to “transfer return information from said telephony/Internet server to said mobile subscriber station specifying at least if the telephony/Internet connection indicated by the Internet address for said specific Internet user is possible) or the similar step of method base Claim 18 (transferring return information from said telephony/Internet server to said mobile subscriber station specifying at least if the telephony/Internet connection indicated by the Internet address for said specific Internet user is possible using the SMS), the

rejection of these base claims is traversed for this reason too. See MPEP §2143.03 and the cases cited therein that establish that a valid *prima facie* case of obviousness requires that all claim limitations must be taught or suggested.

Moreover, as Claims 11 and 17 depend from Claim 1 and Claims 28, 32, and 34 all ultimately depend from Claim 18, the rejection thereof as being obvious over these references is traversed for the reasons noted above as to base system Claim 1 and base method Claim 18.

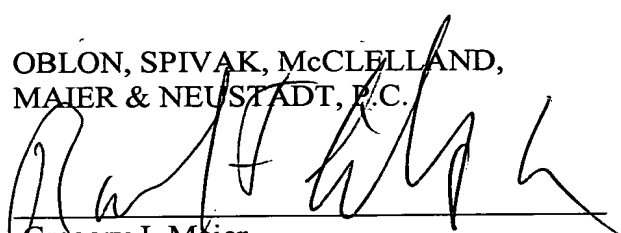
Turning to the rejection of Claims 2-4 and 19-21 as being unpatentable over Coiera in view of Voit in further view of Xu and the rejection of Claims 14 and 31 as being unpatentable over Coiera in view of Voit in further view of Dussell, it is noted that Xu and/or Dussell do not correct the above-noted deficiencies of Coiera and/or Voit. Accordingly, even if actual and reasonable motivation had been established to combine the teachings of all of these clearly disparate references, which is not the case, the result would still not include all the subject matter of base independent Claims 1 or 18. Therefore, as Claims 2-4 and 14 all ultimately depend from base Claim 1 while Claims 19-21 and 31 all ultimately depend on base Claim 18, their rejection as being unpatentable over Coiera in view of Voit taken with either Xu or Dussell is traversed for the reasons noted above..

CONCLUSION

In view of the foregoing amendment and remarks, it is respectfully submitted that no further issues remain outstanding in the present application, and that this application is clearly in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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